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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,162	03/11/2004	Bernhard Gruenewald	H 5336 PCT/US	5098

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HENKEL CORPORATION
THE TRIAD, SUITE 200
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GULPH MILLS, PA 19406

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,162

Applicant(s)

GRUENEWAELDER ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 14-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 14 recites “one other non-incorporable catalyst”. There is not antecedent basis for “other non-incorporable catalyst” and “other” makes it appear as if there is already a “non-incorporable catalyst” in the compositions of claim 1. It is therefore unclear if claim 1 requires a “non-incorporable catalyst” or if “other” refers to a mixture of such catalysts being required by claim 14.

In view of “other non-incorporable catalysts” and the fact that the amino polyol compound of the instant claims is also a catalyst, there is not antecedent basis for “the catalyst” of the instant claim 15. It is therefore unclear if “the catalyst” of claim 15 refers to the “non-incorporable catalyst” of claim 14 or any catalyst present including the amino polyol of the instant claims. This makes the determination of the claimed weight ratios confusing.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-2 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/44847 Burns et al..

Burns et al. disclose the instantly claimed adhesive compositions at the abstract; page 3, lines 10-31, particularly line 29; page 4, lines 1-31, particularly 25-31; page 5, lines 1-30, particularly line 20 which falls within the scope of the instant claim 16 while the remainder encompasses the “aminopolyether polyol” of the instant claims as does page 6, lines 1-26; page 6, lines 28-29; page 7, lines 1-31, particularly 10-13 of which DMDEE falls within the scope of the instant claim 17; and the remainder of the document. Page 5, lines 22-25 encompasses the instant claims 11 and 13. Page 4, lines 19-20 falls within the scope of the instant claim 12. If the aminopolyether polyol is intended to be part of “the catalyst” of claim 15, the aminopolyether polyol of the reference plus the exemplified amounts of DMDEE (e.g. page 20, lines 25-27) fall within the scope of the instant claim 15. No alkali metal ions are present which falls within the scope of the instant claim 2.

5. Claims 1-2 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/44847 Burns et al..

Burns et al. disclose the instantly claimed adhesive compositions at the abstract; page 3, lines 10-31, particularly line 29; page 4, lines 1-31, particularly 25-31; page 5, lines 1-30, particularly line 20 which falls within the scope of the instant claim 16 while the remainder encompasses the “aminopolyether polyol” of the instant claims as does page 6, lines 1-26; page 6, lines 28-29; page 7, lines 1-31, particularly 10-13 of which DMDEE falls within the scope of the instant claim 17; and the remainder of the document. Page 5, lines 22-25 encompasses the instant claims 11 and 13. Page 4, lines 19-20 falls within the scope of the instant claim 12. If the

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aminopolyether polyol is intended to be part of "the catalyst" of claim 15, the aminopolyether polyol of the reference plus the exemplified amounts of DMDEE (e.g. page 20, lines 25-27) fall within the scope of the instant claim 15. No alkali metal ions are present which falls within the scope of the instant claim 2.

It would have at least been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of materials which fall within the scope of the instant claims because they are encompassed by Burns and would have been expected to give the adhesives having the properties discussed by Burns. No unexpected results are seen in a manner commensurate in scope with the instant claims and the cited prior art.

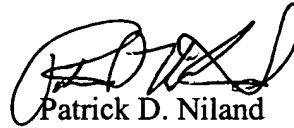
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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